

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD C. JOHNSON, and
JEFFREY SPILFOGEL

Appeal No. 2004-0203
Application No. 09/780,320

MAILED

FEB 19 2004

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before PAK, WALTZ, and KRATZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's refusal to allow claim 1, the only claim pending in this application, as amended subsequent to the final rejection (see the amendment dated Aug. 13, 2001, Paper No. 5, entered as per the Advisory Action dated Oct. 24, 2001, Paper No. 8). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to seamless brassiere shoulder straps formed by finishing the raw cut edges of the fabric assembly of the strap by fusing and cutting the fabric

Appeal No. 2004-0203
Application No. 09/780,320

at a selected site running along the raw cut edges using a known heat sealing and cutting technique (Brief, page 2). A copy of the sole claim on appeal is attached as an Appendix to this decision.

The examiner has relied upon Hyams et al. (Hyams), U.S. Patent No. 5,165,113, issued on Nov. 24, 1992, as support for the sole rejection on appeal, namely the rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated by Hyams (Answer, page 3, referring to the rejection as set forth in the final rejection of Paper No. 4).¹ We *affirm* this rejection essentially for the reasons of record in the Answer, the final rejection, and those reasons set forth below.

OPINION

The examiner finds that Hyams discloses a seamless shoulder strap comprising upper and lower elongated strips of fabric creating an internal compartment therebetween, with an intermediate strip of thermoplastic fiber located in this internal compartment (Paper No. 4, page 3). The examiner further finds that Hyams teaches that these fabric strips are heat fused together and excess

¹The final rejection of claim 1 under the second paragraph of 35 U.S.C. § 112 has been withdrawn in view of appellants' amendment subsequent to the final rejection (Brief, page 2; see the amendment dated Aug. 13, 2001, Paper No. 5, and the Advisory Action dated Oct. 24, 2001, Paper No. 8).

Appeal No. 2004-0203
Application No. 09/780,320

raw edges of the fabric strips are cut off without an "inturned" seam (*id.*).

The examiner further finds that the claimed limitation regarding a selected transverse dimension of the intermediate strip as a work-in-process does not define the construction of the finished article, and thus is of "no patentable significance" (Answer, page 3).

We agree with the examiner that appellants' claim 1 recites a "seamless shoulder strap" comprising a superposed cooperating pair of upper and lower elongated fabric strips in facing relation, oriented to form an elongated internal compartment, with any claimed process limitations not further limiting the finished article. See *In re Wertheim*, 541 F.2d 257, 271, 191 USPQ 90, 103 (CCPA 1976); *In re Hirao*, 535 F.2d 67, 69, 190 USPQ 15, 17 (CCPA 1976) (in claims drafted in product-by-process format, the patentability of the products defined by the product-by-process claims, and not the processes for making them, is what must be gauged in light of the prior art). The examiner also has a lesser burden of proof in establishing anticipation/obviousness when the claims are drafted in a product-by-process form. See *In re Fessman*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974); *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The

Appeal No. 2004-0203
Application No. 09/780,320

examiner has found that the seamless bra shoulder strap having fused edges creating a compartment containing a padded portion, as disclosed by Hyams, describes every limitation of the finished product of claim 1 on appeal (Answer, page 4), thus shifting the burden to appellants to establish that the claimed shoulder strap differs in some aspect from the product of Hyams. See *In re Brown, supra*:

[W]hen the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.

In such a situation as discussed in *Brown*, the burden of proof shifts to appellants to present such a comparison. See also *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

Appellants argue that the obviousness of the examiner's "transfer of technology" must be demonstrated (Brief, page 4). Appellants further argue that the examiner has provided "no clue" as to where support is found for the assumed reasoning to make the strap like the pad (*id.*). These arguments are not well taken since, as noted by the examiner (Answer, page 3), no "transfer of

technology" was proposed since the bonding of the layers together does not stop at the padded area but covers the entire edge including the strap component 16.

Appellants argue that the different widths of the length portions of 16 and 12 of the integral strap 10 would prohibit cutting lengthwise (Brief, page 5). This argument is not persuasive since the "raw cut edges" are an intermediate process limitation in the claim on appeal and appellants have not persuasively argued why this process step would produce a finished product different than the finished product of Hyams.

As correctly argued by appellants in the Reply Brief (pages 1-2), appellants may claim their product in whatever terms they choose so long as the terms are definite to one of ordinary skill in the art. However, the claim on appeal as construed above is directed to a finished product while the intermediate process limitations have not been shown by appellants to change or differentiate the claimed product from the finished product of Hyams.

For the foregoing reasons and those stated in the final rejection and the Answer, we determine that the examiner has established a *prima facie* case of anticipation which has not been adequately rebutted by appellants. Accordingly, we affirm the

Appeal No. 2004-0203
Application No. 09/780,320

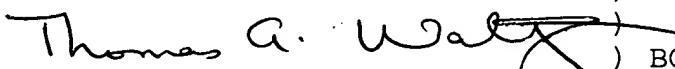
examiner's rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated by Hyams.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

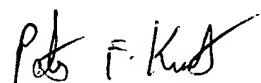


CHUNG K. PAK
Administrative Patent Judge



THOMAS A. WALTZ
Administrative Patent Judge

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PETER F. KRATZ
Administrative Patent Judge

TAW/dal

Appeal No. 2004-0203
Application No. 09/780,320

MYRON AMER, P.C.
Suite 310
114 Old Country Road
Mineola NY 11501

APPENDIX

1. A seamless shoulder strap of a brassiere comprising a superposed cooperating pair of an upper and of a lower elongated strip of fabric construction material in facing relation to each other characterized by opposite edges extending lengthwise of said elongated strips and oriented in parallel relation to each other and bounding therebetween a correspondingly elongated internal compartment, each said strip as a work-in-process having cut raw edges therealong delimiting therebetween a selected first transverse dimension, an intermediate strip of thermoplastic fibrous material having an interposed operative position disposed lengthwise in said internal compartment, said intermediate strip as a work-in-process having cut raw edges therealong delimiting therebetween a selected transverse dimension slightly in excess of said first transverse dimension of said upper and lower fabric strips, said size differences of said first and second transverse dimensions presenting in superposed relation said work-in-process cut raw edges of said upper, lower and intermediate fabric strips which are fused along a selected site together and after said fusing said superposed upper, lower and intermediate fabric strips converted into said seamless shoulder strap of a brassiere by the removal by cutting along said site of said raw edges, whereby appearances of cut raw edges of said upper, lower and intermediate strips are obviated in the resulting shoulder strap.